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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,642	01/29/2004	Scott P. Steinmann	630666.91179	5403
26710	7590	05/28/2008	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497				MILLER, CHERYL L
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
05/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/767,642	STEINMANN, SCOTT P.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHERYL MILLER	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 March 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4-10 and 27-33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4-10, and 27-33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4-10, and 27-33 have been considered but are moot in view of the new ground(s) of rejection.

The Martin US 6,656,225 B2 rejection has been maintained therefore the examiner has responded to the applicants arguments regarding this patent. The applicant has argued that Martin does not disclose movement in two directions when the head is secured to the stem, because element 20 must be secured to element 30 and when they are connected, movement in only one direction occurs. Although movement may only occur in one direction when 30 is secured to 20, movement may occur in two directions when 30 is secured to 10 (without the use of 20). Element 30 used alone with stem 10 (which Martin has the *capability* of) will allow movement in two directions (axially and transversely). Martin discloses a head (30) and stem (10) thus discloses the claimed components. Head component (30) is capable of fitting onto stem component (10), since it has the same sized groove opening (36) as element (20) so as to provide translational movement through the groove of head (30). Axial movement is also permitted by the head (30) as it has a cylindrical opening (34) that has the capability of being placed over mounting portion of stem (10). In summary, although Martin discloses using the device with three assembled components, 10, 20, and 30, element 20's use is irrelevant as this is a product claimed and the two claimed elements of a stem 10 and head 30 are disclosed and further are sized, configured, and capable of assembly together, thus a head (30) and stem (10) fitted together in the manner claimed is disclosed by Martin.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 8 each recite, “the head can be placed *in* an end portion of the stem” in line 4 of each claim. The embodiment shown in figures 8-12 show the head placed over the stem, not *in* an end portion of the stem. It is not clear how the head would fit in the stem, as there is no opening in the stem to place the head in. Claims 2, 4-7 and 9-10 depend upon claims 1 and 8 and inherit all problems associated with the claim.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-10, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 6,656,225 B2, cited in IDS). Referring to claims 1, 2, 5-10, 27, 28, and 30-32, Martin discloses a prosthesis (fig.9, 10) comprising a stem (10), a head (30) having an outer wall (32) that can be placed over the end of the stem (head 30 has the capability of fitting over stem 10) the outer wall having at least one opening (Martin discloses alternate securement means to

the protuberances, such as a screw connection to stem, which would inherently be placed through an opening; col.9, lines 19-25), the wall being dimensioned to be capable of movement in an axial direction and transverse direction relative to the stem axis (part 30 is capable of movement with respect to part 10-it is noted that although Martin shows three components 10, 20, and 30 assembled together, part 20 need not be used by the surgeon; Martin's device is sized and shaped such that part 30 may be attached to part 10 in the manner claimed), the outer wall (32) including a concave surface (37) for interfacing with another bone such as the capitellum of the humerus, the wall (32) having a periphery (side) that is capable of mating with the ulna; and a screw (alternate connection; col.9, lines 19-25) adapted for contacting the stem end, the prosthesis for replacement of the head of a radius (col.1, lines 5-15) and being elliptical (Martin's head is cylindrical, having a circular cross section or plan view; a circle is an ellipse; an ellipse is defined as a curve having two foci, however when the two foci coincide or are equal, the ellipse is a circle; thus Martin's circle reads on the ellipse claimed). Martin discloses the prosthesis substantially as claimed, having a stem (10), head (30) and screw (disclosed) for securing the head to the stem, however, Martin is silent to mention or show the exact location of the screw connection (it is claimed to contact the side of the stem). It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the screw at the side surface of the head (and stem) since the head has only a side periphery surface and a top articulating surface and one having ordinary skill in the art would not want to place a screw on the top articulating surface since this structure would interfere with articulation and additionally form debris, therefore the only obvious placement would be away from the articulation surface, thus on the side surface of the head.

Referring to claims 4, 29, and 33, Martin discloses a prosthesis having a stem and head adapted to be secured onto the stem by an opening/screw connection (see above). Although Martin mentions the use of a screw to secure the head to the stem through an opening (col.9, lines 19-25), Martin does not disclose a particular number of screws/openings (such as three claimed). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have three screw openings, since the result would be merely further security and a duplication of the original parts. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738